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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,301	01/13/2006	Atsushi Kikuchi	Q87762	5170
23373	7590	04/03/2008	EXAMINER	
SUGHRUE MION, PLLC			AUGHENBAUGH, WALTER	
2100 PENNSYLVANIA AVENUE, N.W.				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037			1794	
			MAIL DATE	DELIVERY MODE
			04/03/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/533,301	KIKUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	WALTER B. AUGHENBAUGH	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
  - 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/29/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, drawn to a preform.

Group II, claims 6-8, drawn to a method of making a preform.

Group III, claim 9, drawn to a container.

2. Evidence of lack of unity between groups I, II and III is found in, for example, JP 2000-25729 wherein it is found to disclose the features of instant claim 6. As such, the special technical features of the claimed invention are not found to define a contribution over the prior art under PCT Rule 13.2.

3. During a telephone conversation with Abraham Rosner on March 24, 2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaya et al. (USPN 6,004,638).

In regard to claim 1, Kaya et al. teach that “conventional” polyesters used as the composition of polyester bottles (and performs, see, for example, col. 1, lines 6-12) such as polyethylene naphthalate exhibit a half time of crystallizing of about 500 to 1000 seconds (col. 7, lines 34-38), so “conventional” polyesters such as polyethylene naphthalate require more than 300 seconds to reach a maximum calorific value of isothermal crystallization at 210°C.

In regard to claim 2, Kaya et al. teach that “conventional” polyesters used as the composition of polyester bottles (and performs, see, for example, col. 1, lines 6-12) such as polyethylene terephthalate exhibit a half time of crystallizing of about 200 to 300 seconds (col. 7, lines 34-38), so “conventional” polyesters such as polyethylene terephthalate that require 300 seconds to reach a maximum calorific value of isothermal crystallization at 210°C falls within the scope of the teaching of Kaya et al. of performs of polyethylene terephthalate. The polyethylene terephthalate of a preform of polyethylene terephthalate contains only repeating units of ethylene terephthalate, so the “ratio” (as claimed) of ethylene terephthalate units in the polyethylene terephthalate of a preform of polyethylene terephthalate is 100%.

In regard to claim 3, recycled polyester resins fall within the scope of the teaching of Kaya et al. of “conventional” polyesters (col. 7, lines 34-38). For example, recycled polyethylene terephthalate is polyethylene terephthalate.

#### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaya et al. (USPN 6,004,638) in view of Kanda et al. (USPN 7,258,929).

Kaya et al. teach the preform as discussed above.

In regard to claim 4, Kaya et al. fail to teach that the preform comprising another layer as recited in claim 4.

Kanda et al., however, disclose a preform (col. 3, line 43) comprising a gas barrier layer comprising a polyamide and a layer comprising a thermoplastic resin such as polyester (col. 2, lines 57-61 and col. 5, lines 54-58). Therefore, one of ordinary skill in the art would have recognized to have added a barrier layer to the “conventional” preform of Kaya et al. in order to improve the barrier capabilities of the bottle to be formed from the preform since it is well known to form multilayered bottles including a barrier layer from multilayered performs as taught by Kanda et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a barrier layer to the “conventional” preform of Kaya et al. in order to improve the barrier capabilities of the bottle to be formed from the preform since it is well

known to form multilayered bottles including a barrier layer from multilayered performs as taught by Kanda et al.

In regard to claim 5, Kaya et al. and Kanda et al. teach the preform as discussed above in regard to claim 4.

Furthermore, Kanda et al. teach that a multilayer structure where the outer and inner layers are thermoplastic layers (such as polyester layers) and the barrier layer is the intermediate layer is a suitable structure for the preform (see, for example, col. 6, lines 46-53). Therefore, one of ordinary skill in the art would have recognized to have added another polyester layer to the preform discussed above in regard to claim 4 since a multilayer structure where the outer and inner layers are thermoplastic layers (such as polyester layers) and the barrier layer is the intermediate layer is a suitable structure for a preform to be formed into a bottle as taught by Kanda et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added another polyester layer to the preform discussed above in regard to claim 4 since a multilayer structure where the outer and inner layers are thermoplastic layers (such as polyester layers) and the barrier layer is the intermediate layer is a suitable structure for a preform to be formed into a bottle as taught by Kanda et al.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /  
Patent Examiner, Art Unit 1794

3/30/08